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| 09/711,786      | 11/13/2000  | Alain Marbach        | SAA-49              | 7181             |

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EXAMINER

MASINICK, MICHAEL D

ART UNIT PAPER NUMBER

2125

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/711,786

Applicant(s)

MARBACH ET AL.

Examiner

Michael D Masinick

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-22 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 10-12, 23, 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Coley patent is an automation system for management of licensed software, and the Saitoh patent is factory automation software which would benefit from a license management system because "A significant amount of software piracy occurs in commercial settings" (Coley Col 1, lines 8-46)".
2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
3. It is clear in this case that one skilled in the art at the time the invention faced with the problem of software piracy of a factory automation software product (Saitoh) would have found

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it obvious to look to systems designed to be combined with any piece of software to provide this protection. The Coley patent shows “a program, application, or like composition of code that is preferably nested in a compiled version of a software application” (Column 4, lines 14-17).

Since Saitoh is software, and the problem faced is digital rights protection management, it is clear that this is a valid combination of references.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., details on searching the communication network) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Applicant states “Neither Coley nor Saitoh discloses a monitoring mechanism for searching the communications network for an installation site address.” In looking at the wording of the claim, examiner maintains that this is untrue. The term “searching” can be viewed in many different ways. There are two possible ways of viewing this term that can be used in this rejection.

6. First, the use of IP addresses for associating software with a license is used in both the current invention and in Coley. IP address lookups are done using a methodology where multiple servers must be used in order to find the server (“installation address”) where the software is installed. This simple IP lookup system can be thought of as a search method and read on the claims as written.

7. Second, the term searching could mean the actual searching of a variety of IP addresses in order to find an address on which is installed the software in question. As was stated in the

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response to office action dated 3/24/2004, "Search techniques are taught in the initial freshman class in programming for Electrical Engineering or Computer Science college curriculums..."

8. However, the current claims are written in a manner so that it is unclear whether the installation site address is known to the "search mechanism" and for purposes of this rejection, it is assumed that the installation address is known because each claim previously recites the step of installing a factory automation product at an installation site having an installation site address. Thus, it is not unreasonable to use the first interpretation of the term "searching" as it applies to IP lookup systems and the process of connecting to a known IP address.

9. Examiner maintains that claims as written are able to be interpreted in a very broad manner. Claim rejections are maintained as previously written.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 13-22, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,790,604 to Coley et al in view of U.S. Patent No. 6,038,486 to Saitoh et al.

3. Regarding claims 1 and 20, Coley shows a method of monitoring a product via a communications network, wherein the product includes identifiable information associated

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therewith, and the product is installed at an installation site having an installation site address, said method comprising the steps of and means for: obtaining the installation site address and the identifiable information (Col 8, lines 38-42); and associating the installation site address to the product based on the identifiable information (Col 8, lines 38-42).

4. Coley does not show that this product is a factory automation product. Saitoh et al clearly shows a factory automation software based product which can be accessed and used over the internet which controls machine tools and a variety of other factory automation efforts.

5. It would have been obvious to one of ordinary skill at the time the invention was made to implement the software security and licensing system of Coley as the licensing system of Saitoh or any other factory automation software because “A significant amount of software piracy occurs in commercial settings” (Coley Col 1, lines 8-46).

6. Referring to claim 2, Coley shows wherein the identifiable information comprises a MAC address assigned to the product (Col 18, lines 10-23). Examiner notes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a MAC address as the “other suitable hardware identifier” which is clearly shown in Coley.

7. Referring to claim 3, Coley shows wherein the identifiable information comprises a serial number (“License ID” – Col 9, lines 52-61 and Col 15, lines 19-20).

8. Referring to claim 4, Coley shows wherein the identifiable information comprises a version number (Col 9, lines 4-5).

9. Referring to claim 5, Coley shows wherein the identifiable information comprises a product number (Col 9, lines 1-10).

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10. Referring to claim 6, Coley shows wherein the installation site address is an IP address of the installation site (Col 8, line 42).

11. Referring to claim 7, Saitoh shows where the product is a control device (Figure 1).

12. Referring to claim 8, Coley clearly shows wherein the product comprises a software product.

13. Referring to claim 9, Coley shows wherein the product comprises a host computer (Col 7, lines 43-67).

14. Referring to claims 13 and 14, Coley shows wherein a user of the product is required to register the product over the communications network, and wherein the identifiable information and installation site address is obtained through said registration (Col 8, lines 38-54).

15. Referring to claims 15-17, Coley shows where the product is provided with an embedded mechanism capable of providing a message or message containing address related information, installation site address information, and identifiable information, said method further comprising the step of receiving the signal in order to obtain the information. Examiner notes that any piece of code is "embedded" into a software product, this Coley reads on the claims above as written (Col 8, lines 38-54).

16. Referring to claim 18, Saitoh shows wherein the factory automation system is connected to an equipment, said method further comprising the step of identifying the installation site address of the product based on the connected equipment. Examiner notes that Saitoh clearly shows the ability to communicate over a network with equipment in a fashion well known in the art and that identifying the IP address of a piece of equipment would be no different than any other IP address identification system as is well known in the art or shown in Coley.

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17. Referring to claim 19, Saitoh shows where the factory automation product is associated with a URL in the communications network. Examiner notes that Saitoh clearly shows the ability to communicate over a network with equipment in a fashion well known in the art and that identifying the URL of a piece of equipment would be no different than any other URL identification system as is well known in the art or shown in Coley.

18. Examiner further notes in regards to claims 18 and 19 that it is well known in the art that URL's and IP addresses are interchangeable as address links to servers or other computer machinery.

19. Referring to claim 21, Coley shows wherein the providing means comprises a physical site locator ("IP Address", Col 8 line 42).

20. Referring to claim 22, Coley shows wherein the providing means comprises an embedded device embedded in the factory automation device. See above rejection of claims 15-17. Examiner views the word "embedded" as part of the computer code which is clearly shown in Coley.

21. Referring to claim 25, Coley shows wherein the communications network includes the Internet and the searching means includes a web search device.

22. Referring to claim 26, Coley shows means for notifying a user of the factory automation product safety or quality issues using the installation site address (Col 20, lines 53-64).

23. Referring to claim 27, Coley shows wherein further information is provided when the product is registered, said associating means further associating the product based on the further information (Col 8, lines 38-43).



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24. Referring to claim 28, Coley shows means for determining whether the product is used in violation of licenses based on the installation site address (Col 15, lines 49-62).

***Allowable Subject Matter***

25. Claims 10-12, 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

26. The following is an examiner's statement of reasons for allowance:

27. While Coley in view of Saitoh as shown above shows a license management system for factory automation software products, neither this reference taken alone or in combination with the prior art of record disclose searching additional IP addresses based upon one installation site IP address. It is this IP searching, in combination with the remaining elements and features of the invention, that the applicant's invention defines over the prior art of record.

28. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

***Conclusion***

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and to the state of the art at the time of invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D Masinick whose telephone number is (703) 305-7738. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MDM



LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

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